

REMARKS

Claims 19-30 and 62-77 are currently pending in the present application. In finding Applicant's arguments filed on December 20, 2007 persuasive, the Examiner issued new grounds of rejection in the outstanding Office Action dated March 17, 2008 to which Applicant traverses below.

Examiner Interview

The Examiner is thanked for the examiner interview and working with Applicant's undersigned representative to expedite prosecution of this case. During the Examiner's Interview, the Examiner required Applicant to point out the "corresponding structure" for the 35 U.S.C. §112 ¶6 "means for imparting" language in Claims 19-21 and 23-30. Upon doing so, the Examiner indicated and agreed that the new grounds of rejection would be withdrawn. Applicant agrees and responds as requested.

Claims 19-30 recite:

means for imparting a prescribed transformation to the video image for warping the video image in a manner, and by an amount, not readily visible to a viewer such that a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by the viewer.

The Specification provides clear support for structure corresponding to the "means for imparting" element. Namely, Tracing Watermark Inserter 104a, 104b provides the additional functionality of imparting a prescribed transformation to the video image for warping the video image in a manner, and by an amount, not readily visible to a viewer such that a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by the viewer. The specification at page 35, lines 8-21, generally describes the Tracing Watermark Inserter 104a, 104b, and pages 36, line 27 – page 37, line 19 describes that by "adding a further level of signal processing that will alter the image,

produced by the playback unit in an imperceptible way” (page 36, lines 27-29), “when the outputs of many playback units are combined...the composite image will be distorted (fuzzy) and not of commercial quality” (page 37, lines 8-10). At least such additional functionality of the Tracing Watermark Inserter 104a, 104b represents the corresponding structure for “means for imparting” element. The Specification continues on and describes the various ways of “warping” in which to “impart[] a prescribed transformation to the video image.”

In accordance with the aforementioned agreement, Applicant respectfully requests that the Examiner withdraw all outstanding rejections now that Applicant has fully complied with the Examiner’s requests. Notwithstanding, for completeness, Applicant responds to each rejection below.

Rejection Under §112

The Examiner rejects claims 19-30¹ under 35 U.S.C. §112, first paragraph, stating that it is unclear how one playback unit can be enabled to be multiple playback units. This rejection is respectfully traversed.

The §112 rejection seems to be predicated on a misunderstanding or misread of the claim language at issue. Claims 19-21, 23-30 do not recite “a playback unit” comprising “multiple playback units” as interpreted by the Examiner. Rather, Claims 19-21, 23-30 each recite a “prescribed transformation” that has certain attributes. Specifically, Claims 19-21, 23-30 each recite a “means for imparting a prescribed transformation *to the video image for warping the video image in a manner, and by an amount, not readily visible to a viewer.*” Also, the prescribed transformation is “*such that a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by*

¹ The grounds of the rejection references language in Claims 19-21, 23-30 only. It is believed that claim 22 has been rejected because of its dependency on claim 19.

the viewer.” In other words, the claims do not require multiple playback units. Rather, it is the attributes of the prescribed transformation claimed.

Accordingly, Claims 19-30 are in full compliance with 35 U.S.C. §112, first paragraph. Withdrawal of the rejection is respectfully solicited.

Rejection Under §103

The Examiner rejects Claims 19-21, 23-30, and 62-77 under 35 U.S.C. §103(a) as being unpatentable over Rhoads (U.S. Patent No. 6,363,159) in view of Saito (U.S. Patent No. 6,182,218) and further in view of Chaum (U.S. Patent No. 5,959,717) and further in view of Official Notice. The rejection is respectfully traversed.

But for the Official Notice, the Examiner appears to take the same position with respect to the combination of Rhoads, Saito, and Chaum. Applicant's arguments in traverse of the combination of Rhoads, Saito, and Chaum previously submitted are more than adequate in overcoming the rejection. For the sake of conciseness, Applicant hereby incorporates by reference those arguments.

Moreover, in the prior response, Applicant stated that Chaum does not disclose warping by an amount not readily visible by a viewer, and in response thereto the Examiner states, “this is a subjective measure, since no specific quantitative measure is provided as to the amount of warping the examiner concludes that it is possible that the warping in Chaum[']s invention would be viewable.” Again, Chaum does not disclose any amount of warping by an amount not readily visible by a viewer, and Applicant disagrees with the Examiner that there is some undisclosed amount of warping imparted by Chaum. It is the Examiner's burden to show sufficient evidence that Chaum discloses warping by an amount not readily visible by a viewer; mere conjecture does not satisfy this burden.

As for the Official Notice, the Examiner takes Official Notice that certain functions are “common and well known in prior art in reference to watermarking protocols,” and concludes that “it would have been obvious...to utilize a mathematical process to warp [an] image in order to create a predictable signature.” Assuming that the Examiner is correct in that certain functions are used in *watermarking protocols*, that fact alone does not make it obvious to use those same functions to “*warp an image* to create a predictable signature.” (Emphasis Added). Indeed none of the cited references disclose “warping the video image in a manner,” such that at least two claim requirements are met: (i) “warping...by an amount, not readily visible to a viewer” and (ii) “such that a composite video image produced by multiple video playback units will be distorted and the distortion of the composite video image can be seen by the viewer.” Just because certain functions may exist for watermarking in no way makes it obvious to use those functions with a “prescribed transformation” to *warp the video image in the manner claimed*. It is clear that the Examiner relies on inappropriate hindsight to arrive at the obviousness conclusion referenced above.

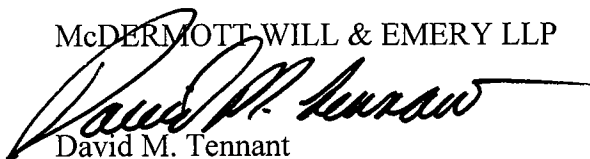
Because all issues have been addressed and presumably overcome, withdrawal of the rejection of claims 19, 20, 21 and 23-30 is respectfully solicited.

Application No.: 09/763,917

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read "David M. Tennant", with a long horizontal flourish extending to the right.

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